

Remarks***I. Status of the Claims***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-2, 6, 8-10, 13-14, 17-18, 20-24, and 26-27 are pending in the application, with claims 1, 13, 22, and 26 being the independent claims. Claims 3-5, 7, 11-12, 15-16, 19, 25, and 28-41 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Applicant reserves the right to pursue the subject matter of these claims in related applications. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

II. Objections to the Claims

In section 4 of the Office Action at page 3, the Examiner has objected to claim 41 because the claim encompasses non-elected embodiments. Claim 41 has been cancelled without disclaimer or prejudice. Thus, this objection has been rendered moot.

III. Objections to the Specification

In section 5 of the Office Action at page 3, the Examiner has objected to the specification for failure to comply with the requirement of 37 C.F.R. § 1.821(d). As requested by the Examiner, the specification has been amended to indicate the SEQ ID

NO for the oligonucleotide primers in paragraphs 0211 and 0212. Hence, this objection is rendered moot.

In section 6 of the Office Action at page 3, the Examiner has objected to the disclosure for a typographical error. As requested by the Examiner, the specification has been amended to correct the typographical error. Hence, this objection is rendered moot.

IV. The Rejections Under 35 U.S.C. § 112, First Paragraph

A. The Enablement Rejection Of Claims 22-40

In section 9 of the Office Action at page 9, the Examiner has rejected claims 22-40 under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the specification in such as way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully disagrees. However, solely to advance prosecution, and not in acquiescence to the Examiner's rejection, Applicant submits herewith a Statement Concerning the Deposited Clone in which Applicant states that the deposit has been made under the terms of the Budapest Treaty and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent. Accordingly, Applicant respectfully requests that the rejection be reconsidered and removed.

B. The Enablement Rejection Of Claims 13-19 and 21

In section 10 of the Office Action at page 4, the Examiner has rejected claims 13-19 and 21 for allegedly not being enabled for antibodies that specifically bind AIM-I polypeptide wherein said polypeptide "comprises" amino acids 39-281 of SEQ ID NO:2.

Applicant respectfully disagrees with rejection. However, to expedite prosecution of the present application and not in acquiescence to this rejection, claim 13 had been amended to recite "consists of" instead of "comprises." Hence, Applicant respectfully asserts that the present invention is enabled for isolated antibodies that specifically bind AIM-I polypeptide wherein said polypeptide consists of amino acids 39-281 of SEQ ID NO:2. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are respectfully requested.

C. The Written Description Rejection Of Claims 13-19 and 21

In section 11 of the Office Action at page 6, the Examiner has rejected claims 13-19 and 21 for allegedly not providing a written description of antibodies that specifically bind AIM-I polypeptide wherein said polypeptide "comprises" amino acids 39-281 of SEQ ID NO:2. Applicant respectfully disagrees with rejection. However, to expedite prosecution of the present application and not in acquiescence to this rejection, claim 13 had been amended to recite "consists of" instead of "comprises." Hence, Applicant respectfully asserts that the present specification provides sufficient written description to convey to one of ordinary skill that Applicant had possession of isolated antibodies that specifically bind AIM-I polypeptide wherein said polypeptide consists of amino acids 39-281 of SEQ ID NO:2. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are respectfully requested.

V. The Rejection Under 35 U.S.C. § 112, Second Paragraph

In section 12 of the Office Action at page 7, the Examiner has rejected claims 1-12, 26-30, and 41 for allegedly being indefinite for failing to point out and distinctly

claim the subject matter which Applicant regards as the invention. As indicated above, claims 3-5, 7, 11-12, 28-30 and 41 have been cancelled without prejudice or disclaimer, thus rendering moot the portion of this rejection that applied to these claims. Applicant has amended claims 1 and 26 to recite "consisting of." Accordingly, this portion of the rejection has been accommodated. Reconsideration and withdrawal of this rejection are respectfully requested.

VI. The Rejections Under 35 U.S.C. § 102(e)

A. The Rejection Over U.S. Patent No. 6,521,228

In section 16 of the Office Action at page 9, the Examiner has rejected claims 1-40 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,521,228 (hereinafter "the '228 patent"). The earliest possible effective filing date for the '228 patent is June 29, 1995. Applicant respectfully traverses this rejection. The '228 patent claims are believed to be directed to subject matter which interferes with the currently pending claims, as defined in 37 C.F.R. § 41.203(a). Accordingly, a showing under 37 C.F.R. § 41.202(d), demonstrating priority over Wiley's '228 patent, and a Request for Interference with a Patent under 37 C.F.R. § 41.202(a) are being filed concurrently herewith, and are believed to constitute a responsive reply to this rejection in full compliance with the requirements of 37 C.F.R. § 1.111. Specifically, it is believed that the showing under 37 C.F.R. § 41.202(d) over the '228 patent establishes conception prior to the effective filing date of the '228 patent coupled with diligence from just prior to the June 29, 1995 effective date of the '228 patent to Applicant's actual and/or

constructive reduction to practice. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

B. The Rejection Over U.S. Patent No. 6,030,945

In section 17 of the Office Action at page 9, the Examiner has rejected claims 1-41 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,030,945 (hereinafter "the '945 patent"). Applicant respectfully traverses this rejection. The earliest possible effective filing date for the '945 patent is January 9, 1996. A showing under 37 C.F.R. § 41.202(d) demonstrating priority over Wiley's '228 patent is being filed concurrently herewith. The attached 202(d) showing constitutes a responsive reply to this rejection in full compliance with the requirements of 37 C.F.R. § 1.111. Specifically, it is believed that the showing under 37 C.F.R. § 41.202(d) over Wiley's '228 patent establishes conception prior to the effective date of the '945 patent coupled with the diligence from just prior to the June 29, 1995 effective date of the '228 patent to Applicant's constructive reduction to practice. Accordingly, it is believed that this showing fulfills the requirements of a declaration of prior invention under 37 C.F.R. § 1.131 sufficient to antedate the disclosure of the '945 patent. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

VII. The Rejections Under 35 U.S.C. § 103(a)

A. The Rejection of Claim 41 Over U.S. Patent No. 6,521,228 In View Of U.S. Patent No. 6,030,945

In section 20 of the Office Action at page 11, the Examiner has rejected claim 41 under 35 U.S.C. § 103 (a) under 35 U.S.C. § 103(a) over the '228 patent in view of the '945 patent. As indicated above, claim 41 has been cancelled without prejudice or disclaimer. Hence, this rejection has been rendered moot.

B. The Rejection Of Claims 1-5, 8-11, 13-16, 18-25, 29-31, 35 And 37 Over Wiley In View Of Campbell

In section 21 of the Office Action at page 12, the Examiner has rejected claims 1-5, 8-11, 13-16, 18-25, 29-31, 35 and 37 under 35 U.S.C. § 103(a) over Wiley *et al.*, *Immunity* 3:673-682 (1995) (hereinafter "Wiley") in view of *Campbell et al.*, *Monoclonal Antibody Technology*, Elsevier Science Publisher, New York, NY, page 1-32 (1984) (hereinafter "Campbell"). Applicant respectfully traverses this rejection.

According to the Examiner, Wiley was first made public in December of 1995. As indicated above, a showing under 37 C.F.R. § 41.202(d) demonstrating priority over Wiley's '228 patent is being filed concurrently herewith. The attached 202(d) showing constitutes a responsive reply to this rejection in full compliance with the requirements of 37 C.F.R. § 1.111. Specifically, it is believed that the showing under 37 C.F.R. § 41.202(d) over Wiley's '228 patent establishes conception prior to the publication date of the Wiley reference coupled with the diligence from just prior to the June 29, 1995 effective date of the '228 patent to Applicant's constructive reduction to practice. Accordingly, it is believed that this showing fulfills the requirements of a declaration of prior invention under 37 C.F.R. § 1.131 sufficient to antedate the disclosure of the Wiley reference. Since Wiley is not available as a reference, it cannot be properly combined with Campbell to allegedly establish obviousness. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

C. The Rejection Of Claims 6-7, 12, 17, 26-28, 32-34, 36, And 38-40 Over Wiley In View Of Campbell And Harlow

In section 22 of the Office Action at page 14, the Examiner has rejected claims 6-7, 12, 17, 26-28, 32-34, 36, and 38-40 under 35 U.S.C. § 103(a) over Wiley in view of

Campbell and *Harlow et al.*, *Antibodies: A Laboratory Manual*, Cold Spring Harbor Laboratory Publication, Cold Spring Harbor, NY, pages 626-629 (1988) (hereinafter "Harlow"). Applicant respectfully traverses this rejection.

As discussed in section B., Applicant has antedated Wiley, thereby removing it as a valid reference. Since Wiley is not available as a reference, it cannot be properly combined with Campbell and Harlow to allegedly establish obviousness. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

D. The Rejection Of Claims 1, 13, 20-21, 22, 24, And 29-30 Over Wiley In View Of U.S. Patent No. 6,180,370

In section 23 of the Office Action at page 15, the Examiner has rejected claims 1, 13, 20-21, 22, 24, and 29-30 under 35 U.S.C. § 103(a) over Wiley in view of U.S. Patent No. 6,180,370 (hereinafter "the '370 patent"). Applicant respectfully traverses this rejection.

As discussed in section B., Applicant has antedated Wiley, thereby removing it as a valid reference. Since Wiley is not available as a reference, it cannot be properly combined with the '370 patent to allegedly establish obviousness. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

E. The Rejection Of Claims 26, 27, 32-33, 35-36, And 38-39 Over Wiley In View Of U.S. Patent No. 6,180,370 And Harlow

In section 24 of the Office Action at page 15, the Examiner has rejected claims 26, 27, 32-33, 35-36, and 38-39 under 35 U.S.C. § 103(a) over Wiley in view of the '370 patent and Harlow. Applicant respectfully traverses this rejection.

As discussed in section B., Applicant has antedated Wiley, thereby removing it as a valid reference. Since Wiley is not available as a reference, it cannot be properly

combined with the '370 patent and Harlow to allegedly establish obviousness. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

F. The Rejection Of Claim 41 Over Wiley In View Of Campbell And U.S. Patent No. 5,858,682

In section 25 of the Office Action at page 17, the Examiner has rejected claim 41 under 35 U.S.C. § 103 (a) as being obvious over Wiley in view of Campbell and U.S. Patent No. 5,858,682 (hereinafter "the '682 patent"). As indicated above, claim 41 has been cancelled without prejudice or disclaimer. Hence, this rejection has been rendered moot.

G. The Rejection Of Claim 41 Over Wiley In View Of U.S. Patent No. 6,180,370 And U.S. Patent No. 5,858,682

In section 26 of the Office Action at page 18, the Examiner has rejected claim 41 under 35 U.S.C. § 103 (a) as being obvious over Wiley in view of the '370 patent and the '682 patent. As indicated above, claim 41 has been cancelled without prejudice or disclaimer. Hence, this rejection has been rendered moot.

VIII. Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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